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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/627,926 | 07/28/2003 | Tai Shui Ho | HOTA3003/EM | 3746 |

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| EXAMINER |
|---|
| RUTLEDGE, AMELIA L |

| ART UNIT | PAPER NUMBER |
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| 2176 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/627,926 | HO ET AL. |
| | Examiner | Art Unit | |
| | AMELIA RUTLEDGE | 2176 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>28 July 2003</u>.

2a)☐ This action is **FINAL**.          2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

1.    This action is responsive to:  original application, filed 07/28/2003.

2.    Claims 1-10 are pending.   Claim 1 is an independent claim.


### *Claim Objections*

Claims 6, 7, 9, and 10 are objected to because of the following informalities:

claims 6, 7, 9, and 10 contain the informal contraction "isn't" rather than the full

expression "is not".  Appropriate correction is required.


### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by**

**Danker et al. ("Danker"), U.S. Patent No. 6,983,305 B2, issued January 2006, filed**

**May 2001.**

**Regarding independent 1**, Danker teaches *a method of converting data*

*containing characters into a corresponding icon on a portable platform*, because Danker

teaches a method of converting character data into a corresponding icon or emoticon in

an instant messaging application on a portable platform with a limited input device (col. 2, l. 53-col. 3, l. 6), including televisions, computers, pagers, cell phones, or any device capable of engaging in an electronic messaging session (col. 2, l. 10-23).

Danker teaches *receiving data containing characters by the platform; finding a character group from the data containing characters for representing an icon according to a predetermined format by an icon conversion module of the platform*; because Danker teaches a method of instant messaging for a limited input device on a network, where a character sequence is associated with a changed status icon or emoticon according to a predetermined format by a conversion module on the network device, caused by a sequence of characters that do not typically occur in written language (col. 10, l. 63-col. 11, l. 50; Fig. 5, 6A, 6B).

Danker teaches *distinguishing the character group from general characters in the data containing characters*; because Danker teaches that specific character sequences in the system represent status icons (col. 11, l. 14-50; Fig. 5, 6A, 6B).

Danker teaches *finding an icon corresponding to the character group and the general characters by the platform; and showing the icon on a display of the platform*, because Danker teaches showing icons based on character groups to represent the user's state, and showing the icons on a display (col. 10, l. 63-col. 11, l. 50).

**Regarding dependent claim 2**, Danker teaches *wherein the platform further comprises an input element, a sending element, first memory storage means, and second memory storage means*, because Danker teaches several network

configurations including input devices, network, signal recorder, central processing unit, ROM, RAM, and mass storage device (Fig. 2, col. 4, l. 10-col. 7, l. 59; col. 8, l. 10-63).

Danker teaches that *the icon conversion module includes an icon database and an icon conversion software*, because Danker teaches an extraction module to search text for a particular series of characters, including a data dictionary storing character information (col. 9, l. 10-23), and Danker teaches how a network device, i.e., icon database and icon conversion software, associated with the user may receive a character sequence resulting in a changed status icon (col. 10, l. 62-col. 11, l. 50).

Danker teaches that *the input element is adapted to input data into the platform, the sending element is adapted to receive or send data containing characters, the first memory storage means is adapted to store the received data containing characters, the second memory storage means is adapted to store the data containing characters to be sent,* because Danker teaches several network configurations including input devices, network, signal recorder, central processing unit, ROM, RAM, and mass storage device (Fig. 2, col. 4, l. 10-col. 7, l. 59; col. 8, l. 10-63). Danker teaches network devices from which the instant message originates, and that the network device contain memory modules to receive character data (col. 9, l. 10-23), and to send a reply instant message, and that the embodiments may comprise multiple computers linked in a networked environment (col. 3, l. 56-col. 4, l. 31).

Danker teaches that *the icon database contains a plurality of character groups and a plurality of icons corresponding the character groups, and the icon conversion software is adapted to analyze and find a character group contained in the data*

*containing characters and convert the same into a corresponding icon*, because Danker teaches an extraction module to search text for a particular series of characters, including a data dictionary storing character information (col. 9, l. 10-23), and Danker teaches how a network device, i.e., icon database and icon conversion software, associated with the user may receive a character sequence resulting in a changed status icon (col. 10, l. 62-col. 11, l. 50). Danker teaches that specific character sequences in the network device represent status icons (col. 11, l. 14-50; Fig. 5, 6A, 6B).

**Regarding dependent claim 3**, Danker teaches *wherein in response to receiving data containing characters from an external source by the sending element of the platform, the received data containing characters is stored in the first memory storage means*, because Danker teaches network devices from which the instant message originates, and that the network device contain memory modules to receive character data (col. 9, l. 10-23), and to send a reply instant message, and that the embodiments may comprise multiple computers linked in a networked environment (col. 3, l. 56-col. 4, l. 31).

Danker teaches that *the icon conversion software analyzes the data containing characters in the first memory storage means, all characters of the character group in the data containing characters are compared with respective character groups of the icon database sequentially*, because Danker teaches an extraction module to search text for a particular series of characters (col. 9, l. 10-23), and analyzing a character sequence in an instant message (col. 11, l. 14-50).

Danker teaches that *the icon conversion software converts the character group in the data containing characters into a corresponding icon if the character group in the data containing characters is matched with the character group of the icon database, and show the corresponding icon n the display,* because Danker teaches showing icons based on character groups to represent the user's state, and showing the icons on a display (col. 10, l. 63-col. 11, l. 50).

**Regarding dependent claim 4**, Danker teaches *wherein prior to sending data containing characters from the platform the data containing characters is stored in the second memory storage means by means of the input element,* because Danker teaches several network configurations including input devices, network, signal recorder, central processing unit, ROM, RAM, and mass storage device (Fig. 2, col. 4, l. 10-col. 7, l. 59; col. 8, l. 10-63). Danker teaches network devices from which the instant message originates, and that the network devices contain memory modules to receive character data (col. 9, l. 10-23), and to send a reply instant message, and that the embodiments may comprise multiple computers linked in a networked environment (col. 3, l. 56-col. 4, l. 31).

Danker teaches *the icon conversion software analyzes the data containing characters in the second memory storage means, converts the character group in the data containing characters into a corresponding icon based on the matched character group in the icon database, and shows the corresponding icon on the display,* because Danker teaches showing icons based on character groups to represent the user's state, and showing the icons on a display (col. 10, l. 63-col. 11, l. 50).

   **Regarding dependent claim 5**, Danker teaches *wherein in response to*
*receiving data containing characters by the sending element of the platform a CPU*
*(central processing unit) of the platform performs steps comprising: storing the data*
*containing characters in the first memory storage means*; because Danker teaches
network devices from which the instant message originates, and that the network device
contain memory modules to receive character data (col. 9, l. 10-23), and to send a reply
instant message, and that the embodiments may comprise multiple computers linked in
a networked environment (col. 3, l. 56-col. 4, l. 31).

   Danker teaches *causing the icon conversion software to determine whether there*
*is a character group in the data containing characters*; since Danker teaches a method
of instant messaging for a limited input device on a network, where a character
sequence is associated with a changed status icon or emoticon according to a
predetermined format by a conversion module on the network device, caused by a
sequence of characters that do not typically occur in written language (col. 10, l. 63-col.
11, l. 50; Fig. 5, 6A, 6B).

   Danker teaches *if there is a character group in the data containing characters,*
*determining whether the character group in the data containing characters is matched*
*with a character group in the icon database; and if the character group in the data*
*containing characters is matched with a character group in the icon database, finding an*
*icon corresponding the matched character group in the icon database, showing the*
*corresponding icon on the display, and processing the general characters in a typical*
*displaying process*, because Danker teaches that specific character sequences in the

system represent status icons (col. 11, l. 14-50; Fig. 5, 6A, 6B), and Danker teaches

processing the remaining characters by extracting language expressions such as words

and characters and displaying them to the user, along with the manual text entry area

and message text (col. 9, l. 35-col. 10, l. 56; Fig. 4, item 402, 405).

**Regarding dependent claim 6**, Danker teaches *wherein, if there isn't a*

*character group in the data containing characters, processes the data containing*

*characters in a typical displaying process*, because Danker discloses two methods for

processing character data to speed instant messaging text entry in a limited input

device, in addition to a typical display process. One method is for extracting language

expressions from sent or received messages including words and characters and

presenting them to the user for selection (col. 9, l. 35-col. 10, l. 56; Fig. 4, item 402).

The second method is for extracting and associating a character sequence with a

changed status icon or emoticon (col. 10, l. 63-col. 11, l. 50; Fig. 5, 6A, 6B).  Thirdly,

Danker discloses displaying the character data of the text message in a typical

displaying process (Fig. 4, item 405).

**Regarding dependent claim 7**, Danker teaches *wherein, if the character group*

*in the data containing characters isn't matched with a character group in the icon*

*database, processes the data containing characters in a typical displaying process*,

because Danker discloses two methods for processing character data to speed instant

messaging text entry in a limited input device, in addition to a typical display process.

One method is for extracting language expressions from sent or received messages

including words and characters and presenting them to the user for selection (col. 9, l.

35-col. 10, l. 56; Fig. 4, item 402).  The second method is for extracting and associating

a character sequence with a changed status icon or emoticon (col. 10, l. 63-col. 11, l.

50; Fig. 5, 6A, 6B).  Thirdly, Danker discloses displaying the character data of the text

message in a typical displaying process (Fig. 4, item 405).

**Regarding dependent claim 8**, Danker teaches *wherein in response to sending*

*data containing characters by the sending element of the platform the CPU of the*

*platform performs steps comprising: storing the data containing characters to be sent in*

*the second memory storage means*; because Danker teaches several network

configurations including input devices, network, signal recorder, central processing unit,

ROM, RAM, and mass storage device (Fig. 2, col. 4, l. 10-col. 7, l. 59; col. 8, l. 10-63).

Danker teaches network devices from which the instant message originates, and that

the network devices contain memory modules to receive character data (col. 9, l. 10-

23), and to send a reply instant message, and that the embodiments may comprise

multiple computers linked in a networked environment (col. 3, l. 56-col. 4, l. 31).

Danker teaches *causing the icon conversion software to determine whether there*

*is a character group in the data containing characters; determining whether the*

*character group in the data containing characters is matched with a character group in*

*the icon database*;  since Danker teaches a method of instant messaging for a limited

input device on a network, where a character sequence is associated with a changed

status icon or emoticon according to a predetermined format by a conversion module on

the network device, caused by a sequence of characters that do not typically occur in

written language (col. 10, l. 63-col. 11, l. 50; Fig. 5, 6A, 6B).

Danker teaches *if the character group in the data containing characters is matched with a character group in the icon database, finding an icon corresponding the matched character group, showing the corresponding icon on the display, and processing the general characters in a typical displaying process*; because Danker teaches that specific character sequences in the system represent status icons (col. 11, l. 14-50; Fig. 5, 6A, 6B), and Danker teaches processing the remaining characters by extracting language expressions such as words and characters and displaying them to the user, along with the manual text entry area and message text (col. 9, l. 35-col. 10, l. 56; Fig. 4, item 402, 405).

Danker teaches *sending the converted data containing characters to at least one receiving means in response to receiving a sending command from the input element*, because Danker teaches several network configurations including input devices, network, signal recorder, central processing unit, ROM, RAM, and mass storage device (Fig. 2, col. 4, l. 10-col. 7, l. 59; col. 8, l. 10-63).  Danker teaches network devices from which the instant message originates, and that the network devices contain memory modules to receive character data (col. 9, l. 10-23), and to send a reply instant message, and that the embodiments may comprise multiple computers linked in a networked environment (col. 3, l. 56-col. 4, l. 31).

**Regarding dependent claim 9**, Danker teaches *wherein, if there isn't a character group in the data containing characters, processes the data containing characters in a typical sending process*, because Danker discloses two methods for processing character data to speed instant messaging text entry in a limited input

device, in addition to a typical display process. One method is for extracting language

expressions from sent or received messages including words and characters and

presenting them to the user for selection (col. 9, l. 35-col. 10, l. 56; Fig. 4, item 402).

The second method is for extracting and associating a character sequence with a

changed status icon or emoticon (col. 10, l. 63-col. 11, l. 50; Fig. 5, 6A, 6B).  Thirdly,

Danker discloses displaying the character data of the text message in a typical

displaying process (Fig. 4, item 405).

      **Regarding dependent claim 10,** Danker teaches *wherein, if the character group*

*in the data containing characters isn't matched with a character group in the icon*

*database, processes the data containing characters in a typical sending process*,

because Danker discloses two methods for processing character data to speed instant

messaging text entry in a limited input device, in addition to a typical display process.

One method is for extracting language expressions from sent or received messages

including words and characters and presenting them to the user for selection (col. 9, l.

35-col. 10, l. 56; Fig. 4, item 402).  The second method is for extracting and associating

a character sequence with a changed status icon or emoticon (col. 10, l. 63-col. 11, l.

50; Fig. 5, 6A, 6B).  Thirdly, Danker discloses displaying the character data of the text

message in a typical displaying process (Fig. 4, item 405).


*Conclusion*

      The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

| Miyazawa et al. | U.S. Pub. No. 2001/0018703 A1 | published | August 2001 |
| Ostermann et al. | U.S. Patent No. 6,990,452 B1 | issued | January 2006 |
| Lee | U.S. Patent No. 7,111,044 B2 | issued | September 2006 |
| Jenniges et al. | U.S. Patent No. 6,978,136 B2 | issued | December 2005 |
| Kredo et al. | U.S. Patent No. 6,876,728 B2 | issued | April 2005 |

Day, et al., "Network Working Group Request for Comments: 2779", published by
    the Internet Society, February 2000, p. 1-34.
    (discloses methods of notifying users of change in state with instant
    messages)

Day, et al., "Network Working Group Request for Comments: 2778", published by
    the Internet Society, February 2000, p. 1-22.
    (discloses methods of notifying users of change in state with instant
    messages)

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to AMELIA RUTLEDGE whose telephone number is

(571)272-7508.  The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached on 571-272-4137.  The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amelia Rutledge/
Examiner, Art Unit 2176